

Appl. No. : 10/001,736
Filed : October 31, 2001

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Discussion of Claim Rejections under 103(a)

In the Office Action, the Examiner rejected Claims 1-4, 6-8, 11, 12, 16, 19-22, 24-26, 28-31, 33 and 33 and 36 as being unpatentable over U.S. Patent No. 5,777,680, to Kim in view of U.S. Patent No. 6,760,478, to Adiletta.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited prior art fails to teach or suggest in isolation or in combination at least one limitation from each of the above-listed independent claims.

In the Office Action, it was recognized that Kim fails to describe the second sub-encoding having a characteristic indicative of energy as is claimed. In the Office Action, the Examiner stated that this limitation was taught or suggested by Adiletta. The Examiner stated:

Adiletta discloses a two-pass encoding method which "adapts at least one parameter based upon a characteristic indicative of an energy content, the characteristic being determined by prediction at least in part on only those frames that are a reference frame" (Adiletta: column 13, lines 37-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Kim and the encoding taught by Adiletta in order to obtain an effective real-time compression algorithm.

Applicant respectfully submits that Adiletta fails to teach or suggest an encoder as is claimed. Claim 1 recites: "performing a second sub-encoding on the first sub-encoded block, the second sub-encoding adapting at least one encoding parameter based upon characteristic indicative of an energy content of the first sub-encoded part of the current frame, the characteristic being determined by prediction without using the first sub-encoded block of a current frame and at least in part from of the frames of the sequence only those frames that are a reference frame." Applicant respectfully submits that the italicized limitation is not taught or

suggested by the cited references. Applicant respectfully submits that the cited section wholly fails to predict characteristics of a current frame based upon a reference frame. In Adiletta, the section cited by the Examiner relates to determining actual differences between the current frame and a reference frame. Adiletta states: "The AC and DC energy are, in effect, a characterization of the amount of change between the reference frame and the current frame." See col. 13, lines 30-32. Thus, Adiletta is not dealing with predictions. One benefit of the present encoding process is that avoids unnecessary access to the current frame. For example, if it is known in advance via prediction that a "current frame" is to be skipped, then the encoding process is simplified. It is to be appreciated that the characteristic may be determined prior to buffering of the current frame. See new Claim 39 and pps. 6 and 16 of the specification.

Furthermore, in the Office Action, the Examiner took the position that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Kim and add the encoding scheme taught by Adiletta in order to obtain an effective real-time compression algorithm." Applicant submits that this finding does not support a prima facie rejection. Applicant submits that the prior art must suggest the desirability of the claimed invention and combination of such features. See M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish prima facie obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. *Id.* In this case, the Examiner has merely made conclusory findings regarding the motivation to modify the Kim system with Adiletta. Applicant respectfully submits that the Examiner has failed to provide a prima facie rejection and that the rejected claims are in condition for allowance.

Furthermore, with respect to new dependent Claims 39-58, Applicant respectfully submits that the cited prior art fails to teach or suggest "wherein the characteristic is determined prior to buffering the current frame." For example, in the Office Action, the "characterization" described in Adiletta uses data from the current frame to determine the AC and DC energy. Thus, in Adiletta, these characteristics are not determined "before buffering the current frame", as is claimed. Since the cited art fails to teach at least this limitation, Applicant respectfully submits that these claims are allowable for at least the reasons discussed above and the subject matter of their own limitations.

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Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the noted rejections and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if an issue requires clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve any such issue promptly.

Respectfully submitted,

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